

RESPONSE*Comment K5!*

Claims 1-8 are pending in this application. The Examiner has rejected claims 1-8 under U.S.C. 35 §112 (second paragraph), and claims 1-8 under U.S.C. 35 §102(e) as anticipated by Park et al U.S. Patent Number 6,255,381, or in the alternative as obvious under U.S.C. 35 §103(a) over Park et al U.S. Patent Number 6,255,381.

Applicants are herein amending claim 1, and canceling claim 3. Applicants respectfully submit that the amendments do not introduce new matter because they are supported by language in the specification on page 14, lines 8-13.

Rejection under 35 U.S.C. § 112 (Second Paragraph)

The Examiner has rejected claims 1-8 under 35 U.S.C. § 112 (second paragraph), asserting that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention because the terms “organic binder” and “solid particulate organic polymer” are indeterminate in scope. Applicants respectfully traverse because the specification provides a clear and definite scope for both of these terms.

The Examiner asserts that the scope of an “organic binder” is unclear. Applicants respectfully traverse because Applicants have provided information pertaining to the method of making the organic polymer, including examples of the monomers that can be polymerized to make the organic binder; the preferred composition of the organic binder; properties of the organic binder, such as glass transition temperature and particle size; and examples of commercially available organic binders. Applicants therefore respectfully submit that the scope of the organic binder is clear and definite.

The Examiner asserts that the scope of a “solid particulate organic polymer” is unclear. Applicants respectfully traverse because Applicants have provided information pertaining to the

method of making the solid particulate organic polymer, including examples of the monomers that can be polymerized to make the solid particulate organic polymer; the preferred composition of the solid particulate organic polymer; and properties of the solid particulate organic polymer, such as glass transition temperature and particle size. Applicants therefore respectfully submit that the scope of the solid particulate organic polymer is clear and definite.

For the above-mentioned reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-8 under 35 U.S.C. § 112 (second paragraph).

Rejection under 35 U.S.C. § 102(e) over Park et al U.S. Patent Number 6,255,381

The Examiner has rejected claims 1-8 under 35 U.S.C. §102(e), over the Park et al reference [U.S. Patent Number 6,255,381], asserting that Park has all of the claimed elements. Applicants respectfully traverse because Park does not disclose (1) a volume ratio of an organic binder to a solid particulate organic polymer in the range of from 1.6:1 to 95:1; (2) the replacement of at least a part of at least one inorganic additive with a solid particulate organic polymer; or (3) the use of his composition for an exterior coating, which are required elements of Applicants' invention, as defined by claims 1-8, as amended.

The Examiner asserts that Park has all of the claimed elements. Applicants respectfully traverse because Park does not disclose a volume ratio of an organic binder to a solid particulate organic polymer in the range of from 1.6:1 to 95:1, which is a required element of Applicants' invention, as defined by amended claim 1, and claims 2-4 and 7-8. Not only does Park not disclose the use of his invention for an exterior elastomeric coating having improved solar reflectance, but he also does not disclose, or even appreciate that improvements in such solar reflectance can be obtained by replacing at least a part of the inorganic additive in a composition containing an organic binder and an inorganic additive with a solid particulate organic polymer. Further, he does not disclose that such improvements in solar reflectance are particularly effective where the volume ratio of the organic binder to solid particulate organic polymer is in the range of from 1.6:1 to 95:1. In light of Park's lack of disclosure of a volume ratio of an

organic binder to a solid particulate organic polymer in the range of from 1.6:1 to 95:1, which is a required element of Applicants' invention, as defined by amended claim 1, and claims 2-4 and 7-8, Applicants respectfully submit that Applicants' claims 1-8 are not anticipated by Park.

Applicants further respectfully traverse because, as noted above, Park does not disclose the replacement of at least a part of at least one inorganic additive in a composition containing an organic binder and an inorganic additive with a solid particulate organic polymer, which is a required element of Applicants' invention, as defined by claims 1-8. The objective of Applicants' invention is to inhibit the inevitable loss, over time, of the solar reflectance of exterior elastomeric coating compositions, especially elastomeric roof coating compositions. Applicants have found that such inhibition is achieved by the replacement of at least a part of the organic additives normally found in exterior elastomeric coating compositions by solid particulate organic polymers having a Tg greater than 70°C. Park does not disclose the replacement of his inorganic compound by any material, much less a solid particulate organic polymer. Thus, he does not disclose the replacement of at least a part of at least one inorganic additive in a composition containing an organic binder and an inorganic additive with a solid particulate organic polymer, which is a required element of Applicants' invention, as defined by claims 1-8. Applicants therefore respectfully submit that Applicants' claims 1-8 are not anticipated by Park.

Additionally, Applicants respectfully traverse because Park does not disclose the use of his composition for an exterior elastomeric coating, which is a required element of Applicants' invention, as defined by claims 1-8. As noted above, the objective of Applicants' invention is to inhibit the inevitable loss, over time, of the solar reflectance of exterior elastomeric coating compositions, especially elastomeric roof coating compositions. The only use disclosed by Park for the composition of his invention is as an antislipping agent for application to packaging boxes made of paper. Clearly a paper packaging box is not an exterior substrate. Thus, Park does not disclose the use of his composition for an exterior elastomeric coating, which is a required element of Applicants' invention, as defined by claims 1-8. Applicants therefore respectfully submit that Applicants' claims 1-8 are not anticipated by Park.

For the abovementioned reasons, Applicants respectfully submit that claims 1-8 are patentable over Park, and request that the Examiner withdraw the rejection of claims 1-8 under 35 U.S.C. §102(e).

Rejection under 35 U.S.C. § 103(a) over Park et al U.S. Patent Number 6,255,381

The Examiner has rejected claims 1-8 under 35 U.S.C. §103(a), asserting that the claims are obvious over the Park et al reference [U.S. Patent Number 6,255,381]. Applicants respectfully traverse because Park does not teach or suggest (1) the replacement of at least a part of at least one inorganic additive with a solid particulate organic polymer; or (2) the use of his composition for an exterior coating, which are required elements of Applicant's invention, as defined by claims 1-8.

Applicants respectfully traverse because Park does not teach or suggest the replacement of at least a part of at least one inorganic additive in a composition containing an organic binder and an inorganic additive with a solid particulate organic polymer, which is a required element of Applicants' invention, as defined by claims 1-8. Applicants achieve their objective of inhibiting the inevitable loss, over time, of the solar reflectance of exterior elastomeric coating compositions, especially elastomeric roof coating compositions, by replacing at least a part of the organic additives normally found in exterior elastomeric coating compositions with solid particulate organic polymers having a Tg greater than 70°C. Park does not mention any replacement of his inorganic compound by any material, much less a solid particulate organic polymer, thus, he does not teach or suggest that any benefit can be derived from such a replacement. Therefore, Park does not provide any motivation for one of ordinary skill in the art to replace at least a part of at least one inorganic additive in a composition containing an organic binder and at least one inorganic additive with a solid particulate organic polymer, which is a required element of Applicants' invention, as defined by claims 1-8. Further, Park does not teach or suggest that there are any deficiencies in his invention that would motivate one of ordinary art

to pursue such replacement. Nor does Park teach or suggest that such replacement is particularly effective for improved solar reflectance where the volume ratio of the organic binder to solid particulate organic polymer is in the range of from 1.6:1 to 95:1, which is a required element of Applicants' invention as defined by claims 1-4, and 7-8. Applicants therefore respectfully submit that Applicants' claims 1-8 are patentable over Park.

Applicants further traverse because Park does not teach or disclose either the use of his composition for an exterior coating, or the use of such a coating for a purpose of inhibiting the loss of solar reflectance, both of which are required elements of Applicant's invention, as defined by claims 1-8. As noted above, the objective of Applicants' invention is to inhibit the inevitable loss, over time, of the solar reflectance of exterior elastomeric coating compositions, especially elastomeric roof coating compositions. Park does not teach or suggest any use for his composition other than as an antislipping agent for application to packaging boxes made of paper. Clearly a paper packaging box is not an exterior substrate, and prevention of slippage is a very different objective from inhibition of loss of solar reflectance over time. Nothing in Park therefore indicates to one of ordinary skill in the art that his composition would work in an exterior application, or that it would be effective for inhibiting loss of solar reflectance. Thus, Park does not motivate one of ordinary skill in the art to use his composition as an exterior coating, or to use such a coating for purposes of inhibiting the loss of solar reflectance, which are required elements of Applicants' invention, as defined by claims 1-8. Applicants therefore respectfully submit that Applicants' claims 1-8 are not anticipated by Park.

For the abovementioned reasons, applicants respectfully submit that claims 1-8 are patentable over Park, and request that the Examiner withdraw the rejection of claims 1-8 under 35 U.S.C. §103(a).

Conclusions

Applicants respectfully requests the Examiner to enter the amendment to the claims and reconsider and withdraw the rejection of claims 1-8 under U.S.C. 35 §112 (second paragraph), under U.S.C. 35 §102(e) over Park et al U.S. Patent Number 6,255,381, and under U.S.C. 35 §103(a) over Park et al U.S. Patent Number 6,255,381.

Attached hereto is a marked up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Please direct all further correspondence to the undersigned, as attorney of record. An Associate Power of Attorney is enclosed.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Claims:

Claim 1 has been amended as follows:

1. [amended] An improved exterior elastomeric coating composition comprising an organic binder, having a Tg less than -20°C, and at least one inorganic additive, and ~~wherein the improvement comprises replacing at least a part of said at least one inorganic additive with~~ a solid particulate organic polymer having a Tg greater than 70°C;
wherein said composition has a volume ratio of said organic binder to said solid particulate organic polymer in the range of from 1.6:1 to 95:1.

Claim 3 has been cancelled:

3. ~~The improved elastomeric coating composition according to claim 1, wherein said solid particulate organic polymer having a Tg greater than 70°C is present in an amount such that a volume ratio of said organic binder to said solid particulate organic polymer having a Tg greater than 70°C is in the range of from 1.6:1 to 95:1.~~